



03-12-2002

U.S. Patent & TMOfo/TM Mail Rcpt. Dt. #40

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of: Rajendra Dayal
Serial No.: 75/138,085
Filed: July 9, 1996
Mark: PUCK
Published in the Official Gazette: Page TM 431 on December 11, 2001

Wolfgang Puck,
Petitioner
vs.
Rajendra Dayal
Respondent

Opposition No.: _____

OPPOSITION TO REGISTRATION
OF TRADEMARK

Box TTAB
FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Dear Sir:

Wolfgang Puck (hereinafter referred to as "Petitioner"), whose postal address is 100 N. Crescent Drive, Suite 100, Beverly Hills, California 90210, by and through its attorneys, brings this petition to oppose the registration of Trademark Application Serial No. 75/138,085 for the mark "PUCK" for "ice cream, flavored ices and frozen yogurt" in international class 30.

Petitioner believes the applicant to be Mr. Rajendra Dayal of Stockbridge, MA (hereinafter

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referred to as "Respondent"). Petitioner believes that he is and will be damaged by registration of the mark and hereby opposes the registration of said mark.

As grounds therefore, it is alleged that:

1. Petitioner is the owner of the following United States Trademark Registrations and Applications for the following marks:

- Reg. No. 1,901,065 for Wolfgang Puck for restaurant services in class 42;
- Reg. No. 1,593,275 for packages and frozen prepared food, namely, pizza and apple, pumpkin and pecan tarts in class 30;
- Reg. No. 2,030,578 for clothing, namely, T-shirts, sweatshirts, polo shirts, sport shirts jackets, hats and caps in class 25;
- Serial No. 74/514290 for packaged and prepared foods, namely, bread, pasta, pasta sauces and macaroni, pasta and rice salads, and salad dressings in class 30;
- Serial No. 76/292837 for broths; fresh, frozen and packaged meals, hors d'oeuvres and entrees consisting of meat, fish, poultry, seafood and/or vegetables; garden, fruit and vegetable salads; pickled vegetables; meat and vegetable extracts; pre-cooked and prepared meats; deli meats; tapenades; vegetable-based spreads; fruit toppings and fillings; jams; jellies; soups; soup mixes; oils and flavored oils in class 29;
- Serial No. 76/363138 for bakery goods; mixes for making bakery goods; bread; bread sticks; croutons; pickle relish; coffee; tea; cakes; cookies; pastries; pies; fresh, frozen and packaged pizza; fresh, frozen and packaged meals; glaces and demi-glaces; hors d'oeuvres and entrees consisting primarily of pasta; macaroni; pasta salads; salad dressings; sauces; vinegar; desserts; hot sauces; relishes; chutneys; frozen, refrigerated and dry desert mixes, including crème brulee mixes; fresh and refrigerated prepared sandwiches in class 30; and
- 75/748135 for household kitchen utensils, namely, kitchen serving tongs, spatulas, turners, whisks, potato mashers, garlic presses, ladles, graters, splatter screens, strainers; containers for household or kitchen use, not of precious metal, mixing bowls, canisters, storage containers for food and beverages with lids; cookware, namely pots, metal, glass and frying pans, skillets, roasters, metal grill pans, stock pots, strainers, colanders; beverage glassware, stemware; dinnerware, plates, saucers, serving dishes, coffee cups, charger plates; bakeware, not toys, namely, cookie sheets, pie pans, baking pans, loaf pans, muffin pans, tube pan with flute sides, cake pans,

knife blocks in class 21; electric cooking utensils, namely, electric knives, electric food blenders for domestic use, electric can openers in class 7; knives, namely, chef knives, kitchen knives, butcher knives, paring knives, bread knives, slicing knives, boning knives, knife sharpeners, carving knives, non-electric can openers, forks, spoons, mandolines in class 8; and domestic electric appliances, namely fry pans, electric grill pans, electric rotisseries, deep fryers, ice cream machines, toaster ovens in class 11 (collectively the "WOLFGANG PUCK" trademarks).

2. Petitioner has adopted and continuously used the "WOLFGANG PUCK" trademarks in interstate commerce at least as early as September 29, 1986 and currently uses the marks, in connection with food related goods and services including, but not limited to, those described in paragraph 1.

3. Petitioner has provided its goods and services under the "WOLFGANG PUCK" trademarks throughout the United States. As a result of the high quality of Petitioner's goods and services, the extensive promotion and public acceptance thereof, Petitioner has gained significant and valuable goodwill for the "WOLFGANG PUCK" trademarks.

4. The public recognizes Petitioner's "WOLFGANG PUCK" trademarks to identify Petitioner's goods and services and to distinguish them from the goods and services of others. The "WOLFGANG PUCK" trademarks function as indicators of origin of Petitioner's goods and services, and as such, are the exclusive property right of Petitioner.

5. Trademark Application Serial No. 75/138,085 sought to be opposed, is for the mark "PUCK" for use with "ice cream, flavored ices and frozen yogurt." Such application was filed on July 9, 1996 and was filed on an intent to use basis. On information and belief Petitioner first used the "WOLFGANG PUCK" trademarks prior to Respondent's first use and filing dates.

6. Because of the substantial and deceptive similarity between the terms, Respondent's alleged mark is likely to cause confusion and lead to deception as to the origin of

Respondent's goods bearing Respondent's alleged mark. People familiar with Petitioner's trademarks would be likely to purchase Respondent's goods as and for goods or services sold by Petitioner. Any such confusion would inevitably result in lost business to Petitioner.

7. Petitioner has expended considerable effort and expense in promoting its "WOLFGANG PUCK" trademarks and the goods and services sold under the marks, with the result that the purchasing public has come to know, rely upon, and recognize the goods and services of Petitioner by such trademarks. Petitioner has an exceedingly valuable goodwill established in the "WOLFGANG PUCK" trademarks.

8. If the Respondent is permitted to attain the registration sought to be opposed, Respondent will have the prima facie exclusive right to use the "PUCK" term in commerce in connection with the goods. Confusion in trade is likely to result from any such concurrent use and registration of the "PUCK" and "WOLFGANG PUCK" trademarks by Petitioner and Respondent, respectively, all to the great detriment of Petitioner.

9. Purchaser and users are likely to consider the goods of Respondent sold under the "PUCK" term as emanating from or sponsored by Petitioner, and to purchase or use such goods as those of Petitioner, resulting in injury to Petitioner.

10. Concurrent use of the two terms by Respondent and Petitioner will result in irreparable damage to Petitioner's reputation and goodwill, if the goods sold by Respondent are inferior, because purchasers are likely to attribute the source or sponsorship of Respondent's goods to Petitioner.

11. If Respondent is permitted to attain the registration, a cloud will be placed on Petitioner's title in and to the "WOLFGANG PUCK" trademarks, and on its right to enjoy the

free and exclusive use thereof in connection with the sale of its goods and services, all to the great injury of Petitioner.

WHEREFORE, Petitioner prays that this Petition for Opposition be granted and that Trademark Application Serial No. 75/138,085 not be allowed to pass to registration.

This Petition for Opposition is filed in duplicate and the required filing fee in the amount of \$300 is enclosed.

Dated: March 12, 2002.

WOLFGANG PUCK
By its attorneys,

By 

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March 12, 2002

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VIA EXPRESS MAIL
NO. EL 724021123 US

Box TTAB
FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Re: Petitioner: Wolfgang Puck
Respondent: Rajendra Dayal
Serial No.: 75/138,085
Mark: PUCK
Our Docket No. 092009-0000008

Dear Sir:

Enclosed please find:

1. Opposition to Registration of Trademark (in duplicate);
2. Certificate of Express Mail Mailing;
3. Filing fee in the amount of \$300.00; and
4. A self-addressed stamped postal acknowledgement card.

Very truly yours,

PILLSBURY WINTHROP^{LLP}

Christopher J. Chaudoir

Enclosures

Box TTAB
FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

SERIAL NO. 75/138,085
MARK: PUCK

CERTIFICATE OF EXPRESS MAIL MAILING

I hereby certify that on March 12, 2002 the enclosed original executed and one copy of Opposition to Registration of Trademark submitted on behalf of Wolfgang Puck, a check in the amount of \$300 and a self-addressed stamped postal acknowledgment card are being deposited with the United States Postal Service, as "Express Mail Post Office to Addressee," mailing label no EL 724021123 US addressed to "Box TTAB, FEE, Assistant Commissioner of Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.



Lisa A. Ralph

March 12, 2002
Date of Signature